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10/826,062	04/16/2004	Cecilia Castillo	2002-0427	9972
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/826,062

**Applicant(s)**

CASTILLO ET AL.

**Examiner**

Samuel G. Neway

**Art Unit**

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/16/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This is responsive to the Application filed on 16 April 2004.
2. Claims 1 – 20 are pending.

### *Double Patenting*

3. Claims 15 – 20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15 – 20 of copending Application No. 10/826,064. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 15 – 20 of the current application are verbatim the same as claims 15 – 20 of copending Application No. 10/826,064.

4. Claims 15 – 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 – 4, and 6 – 7, and also over claims 8, 10 – 11, and 13 – 14 of copending Application No. 10/826,064. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are obvious over the claims of 10/826,064.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Current Application	Copending Application 10/826,064
15. A spoken dialog system generated using automatically-created test dialogs,	1. A method of generating test dialogs from a call flow, the method comprising:

the test dialogs generated according to a method comprising:

converting a call flow developed for the spoken dialog system into a context free grammar notation;

converting the context free grammar notation into a state-based representation;

generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system.

16. The spoken dialog system of claim 15, wherein the context free grammar notation is a Backus-Naur Form (BNF).

17. The spoken dialog system of claim 15, wherein the state-based representation is a finite state machine (FSM).

18. The spoken dialog system of claim 15, wherein the automatically-created test dialogs are used to off-line test the spoken

converting a call flow into a context free grammar notation;

converting the context free grammar notation into a state-based representation; and

generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system.

3. The method of claim 1, wherein the context free grammar notation is a Backus-Naur Form (BNF).

4. The method of claim 1, wherein the state-based representation is a finite state machine (FSM).

6. The method of claim 5, wherein a computing device off-line automatically tests the spoken dialog system using the

<p>dialog system.</p> <p>19. The spoken dialog system of claim 15, wherein the automatically-created test dialogs are used to on-line test the spoken dialog system.</p> <p>15. A spoken dialog system generated using automatically-created test dialogs, the test dialogs generated according to a method comprising:</p> <p style="padding-left: 40px;">converting a call flow developed from the spoken dialog system into a context free grammar notation;</p> <p style="padding-left: 40px;">converting the context free grammar notation into a state-based representation;</p> <p style="padding-left: 40px;">generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system.</p> <p>16. The spoken dialog system of claim 15, wherein the context free grammar notation</p>	<p>generated test dialogs.</p> <p>7. The method of claim 5, wherein a computing device on-line automatically tests the spoken dialog system using the generated test dialogs.</p> <p>8. A dialog generation module for automatically generating dialogs from call flows for use with a spoken dialog system, the module comprising:</p> <p style="padding-left: 40px;">means for converting a call flow into a context free grammar notation;</p> <p style="padding-left: 40px;">means for converting the context free grammar notation into a state-based representation; and</p> <p style="padding-left: 40px;">means for generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system.</p> <p>10. The dialog generation module of claim 8, wherein the context free grammar</p>
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is a Backus-Naur Form (BNF). 17. The spoken dialog system of claim 15, wherein the state-based representation is a finite state machine (FSM). 18. The spoken dialog system of claim 15, wherein the automatically-created test dialogs are used to off-line test the spoken dialog system. 19. The spoken dialog system of claim 15, wherein the automatically-created test dialogs are used to on-line test the spoken dialog system.	notation is a Backus-Naur Form (BNF). 11. The dialog generation module of claim 8, wherein the state-based representation is a finite state machine (FSM). 13. The dialog generation module of claim 12, wherein a computing device off-line automatically tests the spoken dialog system using the generated test dialogs. 14. The dialog generation module of claim 13, wherein a computing device on-line automatically tests the spoken dialog system using the generated test dialogs.
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5. Claims 15 – 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14, and 17 – 18 and also over claims 19, 22 – 23 of copending Application No. 10/826,065. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 10/826,065 anticipate the current claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Current Application	Copending Application 10/826,065
<p>15. A spoken dialog system generated using automatically-created test dialogs, the test dialogs generated according to a method comprising:</p> <p style="padding-left: 40px;">converting a call flow developed for the spoken dialog system into a context free grammar notation;</p> <p style="padding-left: 40px;">converting the context free grammar notation into a state-based representation;</p> <p>generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system.</p> <p>16. The spoken dialog system of claim 15, wherein the context free grammar notation is a Backus-Naur Form (BNF).</p> <p>17. The spoken dialog system of claim 15, wherein the state-based representation is a finite state machine (FSM).</p>	<p>14. A method of generating, executing and validating dialogs for a spoken dialog service, the method comprising:</p> <p style="padding-left: 40px;">converting a call flow associated with a spoken dialog service into a context free grammar notation;</p> <p style="padding-left: 40px;">converting the context free grammar notation into a state-based representation;</p> <p style="padding-left: 40px;">generating dialogs associated with the call flow by analyzing the state-based representation,</p> <p style="padding-left: 80px;">...</p> <p>18. The method of claim 17, wherein the context free grammar notation is a Backus-Naur Form (BNF).</p> <p>17. The method of claim 14, wherein the state-based representation is a finite state machine (FSM).</p>

15. A spoken dialog system generated using automatically-created test dialogs, the test dialogs generated according to a method comprising:

converting a call flow developed for the spoken dialog system into a context free grammar notation;

converting the context free grammar notation into a state-based representation;

generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system.

16. The spoken dialog system of claim 15, wherein the context free grammar notation is a Backus-Naur Form (BNF).

17. The spoken dialog system of claim 15, wherein the state-based representation is a finite state machine (FSM).

19. A spoken dialog service generated according to an automated process comprising:

converting a call flow associated with a spoken dialog service into a context free grammar notation;

converting the context free grammar notation into a state-based representation;

generating dialogs associated with the call flow by analyzing the state-based representation,

...

23. The method of claim 22, wherein the context free grammar notation is a Backus-Naur Form (BNF).

22. The method of claim 19, wherein the state-based representation is a finite state machine (FSM).



### ***Specification***

6. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).
7. The attempt to incorporate subject matter into this application by reference to Attorney Docket No. 2002-0371 is ineffective because the related US Patent Application number is not given.

### ***Claim Objections***

8. Claim 2 is objected to because of the following informalities: in line 1, "the equivalent representation" has no antecedent basis. The Examiner will read the limitation as 'the higher level representation'.
9. Claim 5 is objected to because of the following informalities: in line 2, "teach page" is believed to be a typographical error for 'each page'.

10. Claim 15 is objected to because of the following informalities: in line 3, "fro the spoken dialog" is believed to be a typographical error for 'for the spoken dialog'.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 15 – 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 15 – 20 are directed to a system but there is no other recited element in combination with the system; the claims represent single means claims.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for

achieving the stated property (result) while the specification discloses at most only those known to the inventor.

13. Claims 18 – 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification gives no explicit and deliberate definition of “on-line test”, “off-line test”, and validating the test dialogs.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 13 – 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are directed to “The dialog generation module”. There is insufficient antecedent basis for this limitation in the claim.

The claims recite the limitation “means for ... automatically tests the spoken dialog system”. It is unclear what is meant to be covered by this limitation.

### ***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1, 7 – 8, and 11 – 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Devine et al (US PGPub 2003/0217190).

Claim 1:

Devine discloses a method of converting a call flow into a state-based representation (Abstract), the method comprising:

walking a call flow and converting each page of the call flow into a rule of a higher level representation of the call flow ("The drawing package allows for the created flow charts to be saved in an intermediate language format", [0007]);

augmenting the higher level representation with terminal symbols representing state variable assignments and comparisons associated with decision and computation shapes in the call flow ("an intermediate language format that captures the physical description of the graphical representation of the process as well as information representative of the content in that flowchart", [0007]); and

converting the higher level representation into a state-based representation ("A parser processes these intermediate language documents to create a state event table that can direct the operation of a state machine engine", [0007]).

Claim 7:

Devine discloses the method of claim 1, wherein the call flow comprises at least one page having a set of shapes having specific meanings (Fig. 4 and related text).

Claim 8:

Devine discloses the method of claim 7, wherein the set of shapes having special meaning comprises at least: parallelograms representing rules, lines representing dialog inputs, rectangular boxes representing dialog outputs or actions, diamonds representing Boolean decision functions, hexagrams representing calculation and assignment functions and annotation shapes representation comments (Fig. 4 and related text).

Claim 11:

Devine discloses the method of claim 1, wherein the rule comprises terminal symbols comprising the names used to label shapes and transitions of the call flow ("The translator can process these shapes and connectors to develop a set of instructions, such as a set of XML instructions", [0027]).

Claim 12:

Devine discloses the method of claim 1, further comprising generating a unique terminal symbol in the higher level representation that shadows each rule, input, output, decision and calculation within the call flow ("The translator can process these shapes and connectors to develop a set of instructions, such as a set of XML instructions, that represent the service presented in the drawing.", [0027]).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2 – 3, 5, and 15 – 16 are rejected under 35 U.S.C. 103(a) as being obvious over Devine et al (US PGPub 2003/0217190) in view of Mital et al (USPN 7,184,967).

Claim 2:

Devine discloses the method of claim 1, but it does not explicitly disclose wherein the higher level representation is a context-free grammar representation.

In a similar method, Mital discloses converting a workflow into a higher level representation wherein the higher level representation (XML) is defined in a context-free grammar ("Backus-Naur Form", col. 17, lines 15-17, Fig. 24 and related text).

It would have been obvious to one with ordinary skill in the art at the time of the invention to define the higher level representation in Devine's method in a context-free grammar as disclosed in Mital because context-free grammar is a widely used format for specifying the syntax of a language.

Claim 3:

Devine and Mital disclose the method of claim 2, Mital further discloses wherein the context free grammar notation is a Backus-Naur Form (BNF) (col. 17, lines 15-17, Fig. 24 and related text).

It would have been obvious to one with ordinary skill in the art at the time of the invention to define the higher level representation in Devine's method in a Backus-Naur Form as disclosed in Mital because Backus-Naur Form is a widely used format for specifying the syntax of a language.

Claim 5:

Devine and Mital disclose the method of claim 3, Devine further discloses wherein the step of walking the call flow and converting each page to a BNF occurs automatically via a computing device ("the editor is the Microsoft Visio editor which allows for a created flowchart to be saved an XML format", [0007]).

Claim 15:

Devine discloses a spoken dialog system generated using automatically-created test dialogs ("telephony or telecommunication service", [0006]), the test dialogs generated according to a method comprising:

converting a call flow developed fro the spoken dialog system into higher level representation of the call flow ("The drawing package allows for the created flow charts to be saved in an intermediate language format", [0007]) but it does not explicitly disclose wherein the higher level representation is a context-free grammar representation.

In a similar method, Mital discloses converting a workflow into a higher level representation wherein the higher level representation (XML) is defined in a context-free grammar (col. 17, lines 15-17, Fig. 24 and related text).

It would have been obvious to one with ordinary skill in the art at the time of the invention to define the higher level representation in Devine's method in a context-free grammar as disclosed in Mital because context-free grammar is a widely used format for specifying the syntax of a language.

Devine further discloses converting the higher level representation into a state-based representation ("A parser processes these intermediate language documents to create a state event table that can direct the operation of a state machine engine", [0007]); and

generating dialogs associated with the call flow by analyzing the state-based representation, wherein the generated dialogs may be used to test the spoken dialog system ("the methods described herein include state machine design tools that allow a user to generate state machines by creating and processing a flow chart representation of a telephony service, such as a call waiting service", [0006]).

Claim 16:

Devine and Mital disclose the spoken dialog system of claim 15, Mital further discloses wherein the context free grammar notation is a Backus-Naur Form (BNF) (col. 17, lines 15-17, Fig. 24 and related text).

It would have been obvious to one with ordinary skill in the art at the time of the invention to define the higher level representation in Devine's method in a Backus-Naur Form as is disclosed in Mital because Backus-Naur Form is a widely used format for specifying the syntax of a language.

20. Claims 4, 6, 9 – 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devine et al (US PGPub 2003/0217190) in view of Mital et al (USPN 7,184,967) and in further view of Wallace (USPN 4,686,623).

Claim 4:



Devine and Mital disclose the method of claim 3, but they do not explicitly disclose wherein the state-based representation is a finite state machine (FSM).

It is old and well known in the computing arts to input context-free grammar into a grammar parser and generate a finite state machine as evidenced by Wallace which discloses expressing source code in a context-free grammar which is provided to a grammar parser which in turn generates a finite state machine (col. 2, lines 38-44).

Thus, it would have been obvious to one with ordinary skill in the art at the time of the invention to have the state based representation of Devine's method be finite state machines because they are known and old standards in compiling source code.

Claim 6:

Devine, Mital and Wallace disclose the method of claim 4, Devine further discloses wherein the step of augmenting the BNF with terminal symbols occurs automatically via a computing device ("the editor is the Microsoft Visio editor which allows for a created flowchart to be saved an XML format", [0007]).

Claim 9:

Devine, Mital and Wallace disclose the method of claim 4, Wallace further discloses wherein a grammar compiler is used to convert the BNF into the FSM (col. 2, lines 38-44).

It would have been obvious to one with ordinary skill in the art at the time of the invention to use a grammar compiler to convert BNF into FSM because it is an old and known standard in compiling source code.

Claim 10:

Devine, Mital and Wallace disclose the method of claim 9, Devine further discloses wherein the FSM may be used by at least one spoken dialog tool ("telephony or telecommunication service", [0006]) to perform generation and testing functions associated with a spoken dialog service ("to aid in debugging", [0052]).

Claim 17:

Devine and Mital disclose the spoken dialog system of claim 15, but they do not explicitly disclose wherein the state-based representation is a finite state machine (FSM).

It is old and well known in the computing arts to input context-free grammar into a grammar parser and generate a finite state machine as evidenced by Wallace which discloses expressing source code in a context-free grammar which is provided to a grammar parser which in turn generates a finite state machine (col. 2, lines 38-44).

Thus, it would have been obvious to one with ordinary skill in the art at the time of the invention to have the state based representation of Devine's method be finite state machines because they are known and old standards in compiling source code.

**Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Heeren et al (US PGPub 2003/0041314) discloses a method of converting a call flow diagram into a higher level representation (XML).

b. Sinai et al (USPN 7,143,042) discloses a graphical design tool that allows a developer to graphically author a dialog flow for use in a voice response system and to graphically create an operational link between a hypermedia page and a speech object.

c. Hank et al (USPN 6,321,198) discloses a method of converting a dialogue flow into a machine readable code.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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**DAVID HUDSPETH**  
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